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OFFICE OF PETITIONS

JONES DAY
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In re Patent of Artavanis-Tsakonas et al.	:	DECISION ON REQUEST
Patent No. 7,727,732	:	FOR RECONSIDERATION OF
Issue Date: June 1, 2010	:	PATENT TERM ADJUSTMENT
Application No. 10/781,059	:	AND NOTICE OF INTENT TO
Filing Date: February 17, 2004	:	ISSUE CERTIFICATE OF
Attorney Docket No. 7326-132	:	CORRECTION

This is a decision on the petition filed February 4, 2011, which is being treated as a renewed petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by one thousand three hundred twenty-seven (1,327) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by one thousand three hundred twenty-seven (1,327) days is **GRANTED to the extent indicated herein.**

The instant petition raises the following two issues:

1. Should the period of delay under 37 C.F.R. § 1.703(a) ("A Delay") include a 165-day period of delay under 37 C.F.R. § 1.703(a)(3)?
2. Was the exclusion of a 289-day period from the period of delay under 37 C.F.R. § 1.703(b) ("B Delay") proper?

Issue 1

A final Office action was mailed March 27, 2008.

A Notice of Appeal and a Pre-Appeal Brief Request for Review were filed September 25, 2008.

The Office mailed a Notice of Panel Decision from Pre-Appeal Brief Review on November 3, 2008. The notice stated the application was allowable and stated a Notice of Allowance would be mailed.

The Office mailed a Notice of Allowance on July 10, 2009.

Patentees assert the period of A Delay should include a 165-day period based on the prior facts.

The Office has reviewed the record and agrees the period of A Delay should include a period of delay under 37 C.F.R. § 1.703(a)(3) of 165 days, which is the number of days beginning January 26, 2008, the day after the date four months after the filing of the Notice of Appeal, and ending July 10, 2009, the date the Office issued the Notice of Allowance.

Issue 2

The Office excluded 289 days from the period of B Delay based on a conclusion 289 days were consumed by appellate review.

Patentees argue 0 days were consumed by appellate review.

Patentees' arguments have been considered, but not found persuasive. The period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. *See* 35 U.S.C. § 154(b)(1)(B)(ii). An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. *See* 35 U.S.C. § 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination). In this case, the period consumed by appellate review is 289 days, which is the number of days beginning September 25, 2008, the date the Notice of Appeal was filed, and ending July 10, 2009, the date the Office mailed the Notice of Allowance. Therefore, the Office properly excluded 289 days from the period of B Delay.

It is noted that the Office issued a Notice of proposed rulemaking entitled *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements*, 76 Fed. Reg. 18990 (April 6, 2011). To the extent that the final rule on *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review* revises the interpretation of appellate review applied in this decision, Patentees are given one (1) month or thirty (30) days, whichever is longer, from the date of the final rule to file a request for reconsideration. No extensions of time will be granted under 37 C.F.R. § 1.136.

Nothing in this decision should be construed as a waiver of the requirement set forth in 35 U.S.C. § 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Conclusion

The Office issued a decision dismissing a prior petition on January 4, 2011. The decision asserted the correct patent term adjustment is 1,038 days.

In view of the prior discussion, the correct patent term adjustment is 1,203 days.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **one thousand two hundred three (1,203)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'C. Brantley', is positioned above the printed name.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,727,732 B2
APPLICATION NO. : 10/781,059
DATED : June 1, 2010
INVENTOR(S) : Spyridon Artavanis-Tsakonas et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

The first or sole Notice should read --

Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 862 days.